

### REMARKS

Reconsideration of the Office Action mailed January 12, 2006, (hereinafter "instant Office Action") and withdrawal of the rejection of claims 1-8, 10, 46 and 47, are respectfully requested.

In the instant Office Action, claims 1-8, 10, 11 and 46-52 are listed as pending, claims 11 and 48-51 are listed as withdrawn from consideration and claims 1-8, 10, 46 and 47 are listed as rejected. On page 7 of the instant Office Action the Examiner states that claim 7 is allowed.

Applicants gratefully acknowledge that the Examiner has withdrawn rejection of claims 1-8, 10 and 47 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

The Examiner has maintained the rejection of claims 1-8, 10, 46 and 47 under 35 U.S.C. §103(a) over Calderwood et al., WO 98/41525. Applicants respectfully traverse this rejection and maintain the arguments presented in the Replies filed November 30, 2004, March 26, 2004, July 11, 2003, February 11, 2003 and the RCE filed October 24, 2005. The Examiner states "...the instant claims encompass the reference genus." The Examiner further states that as a result "...the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties." Applicants respectfully point out that the instant claims overlap with the reference genus and that the instant claims do not fully encompass the reference genus. In particular, the definition of L in the instant application differs from the corresponding position, denoted as A in the reference genus. L does not encompass NH, O or alkylene chain. The instant genus overlaps with the reference genus but the reference genus does not teach the instant genus *as a whole*. The instant genus is significantly larger and encompasses many more compounds than the reference genus. There is no motivation in the reference genus for one of ordinary skill in the art to expand the genus as Applicants have done. M.P.E.P. 2142 states "The prior art must teach or suggest all of the claim limitations." WO98/41525 does not teach or suggest Applicants' genus as a whole, that is, all of the definitions provided in the instant application for R<sub>1</sub>, R<sub>2</sub>, L and R<sub>3</sub>. Although the two genres overlap and the reference teaches use

of the compounds as pharmaceutical agents, there is nothing in WO98/41525 to suggest Applicants' genus.

The Examiner points out two compounds in WO98/41525 that fall within Applicants' genus and one compound in WO98/41525 that is structurally analogous to the claimed compounds. The Examiner cites *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA1997) which states:

When chemical compounds have 'very close' structural similarities and similar utilities, without more, a prima facie case may be made.

As stated above, the instant genus overlaps with the genus disclosed in WO98/41525. Despite the overlap there are numerous compounds encompassed by Applicants' genus that do not have very close structural similarity with the genus disclosed in WO98/41525, such as examples 285-289, 291 and 297-301, among others. Therefore, WO98/41525 does not anticipate applicants' genus as a whole.

Based upon the foregoing, the rejection of claims 1-8, 10, 46 and 47 under 35 U.S.C. §103(a) over Calderwood et al., WO 98/41525, is obviated and should be withdrawn.

The Examiner has rejected claims 1-8, 10 and 47 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. The Examiner is unsure what the terms alkylcarboxamido, arylcarboxamido and aralkylcarboxamido are intended to represent. Applicants respectfully traverse this rejection.

One of ordinary skill in the art would understand the meaning of the terms alkylcarboxamido, arylcarboxamido and aralkylcarboxamido. Alkylamido is alkyl-C(O)-NH-R wherein R, in this case, is Ring A. To form an arylamido or aralkylamido, replace the alkyl with aryl or aralkyl. Alkylcarboxamido is alkyl-NH-C(O)-R wherein R, in this case, is Ring A. To form an arylcarboxamido or aralkylcarboxamido, replace the alkyl with aryl or aralkyl.

Based upon the foregoing, the rejection of claims 1-8, 10 and 47 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention, is obviated and should be withdrawn.


Applicants gratefully acknowledge that claim 52 is allowed.

In view of the foregoing remarks, Applicants believe that claims 1-8, 10 and 46, 47 and 52 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that a telephone conference would advance the condition of the instant application for allowance, Applicants invite the Examiner to call Applicants' agent at the number noted below.

Date: May 11, 2006

Respectfully submitted,



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